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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/290,027	04/09/99	NOTZ	J 16356.431

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TM02/0606

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/290,027

Applicant(s)
NOTZ et al.

Examiner
Hani Kazimi

Art Unit
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 1999
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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DETAILED ACTION

1. This application has been reviewed. Original claims 1-18 are pending. The rejections cited are as stated below:

Drawings

2. The substitute formal drawings were received on October 1, 1999. These drawings are acceptable for examination purposes only. Formal drawings will be reviewed by the draftsman when the application is allowed.

Specification

3. Examiner corrected page 1 of the specification, the section "Background" according to 37 C.F.R. § 1.77 regarding the required elements of the application. In particular, the status of the co-pending applications serial numbers 09/009,401 and 09/158,564 have been updated to indicate Patents numbers of both applications 6,038,597 and 6,167,383 respectively. Please advise the Examiner if the correction is incorrect.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson et al. US Pat. No. 6,167,383.

Claims 1, and 10, Henson discloses a web-based online store having a user interface for enabling a custom configuration of a computer system according to an identification of a user belonging to a prescribed customer set (abstract), said online store comprising:

a configurator for configuring a computer system with options selected according to a desired user input, the options and a respective pricing for each option being presented on a configurator web page (figure 1, element 18, column 2, line 61 thru column 3, line 12, and column 4, line 53 thru column 5, line 65);

a database for dynamically supplying configuration options to said configurator in accordance with the identification of the user belonging to the prescribed customer set (figure 1, element 24, column 5, lines 55-65, and column 10, line 49 thru column 11, line 31);

a cart for temporarily storing a customer configured computer system and presenting the customer configured computer system on a cart web page, the cart web page further including at least one user selectable cart option (figure 1, element 20, column 2, line 61 thru column 3, line 29, and column 10, line 18 thru column 11, line 51); and

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an interactive upsell advisor operatively coupled to said configurator, said database, and said cart for selectively providing an upsell recommendation to said cart as a user selectable cart option on the cart web page, the upsell recommendation being a function of the prescribed customer set, the customer configured computer system, and prescribed upsell advisor business rules (column 7, lines 39-56, column 9, line 40 thru column 10, line 18, column 13, line 18 thru column 14, line 18, and column 15, lines 46-60).

Claims 2, and 11, Henson discloses a database for dynamically supplying the prescribed upsell business rules to said upsell advisor, said upsell advisor utilizing the dynamically supplied prescribed upsell business rules in selectively providing upsell recommendations to said cart (column 9, line 40 thru column 10, line 23).

Claims 3, and 12, Henson discloses that the upsell advisor calculates a differential price between the customer configured computer system with the upsell recommendation and the customer configured computer system without the upsell recommendation, said upsell advisor further providing the differential price to said cart (figures 1, 3A-3C, and 5, and column 6, lines 18-43).

Claims 4, and 13, Henson discloses that the description of the upsell recommendation, the differential price, and an upgrade now user selectable option are each displayed on

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the cart web page (figures 3A-3C, and 5, column 9, line 56 thru column 10, line 18, and column 15, line 45 thru column 16, line 5).

Claims 5, and 14, Henson discloses that upon selection of the upgrade now option by the user, said upsell advisor updates the customer configured computer system configuration with the upsell recommendation and then returns the user to said cart.

Claims 6, and 15, Henson discloses the description of the upsell recommendation, the differential price, and an upgrade now user selectable option are further displayed in a prominent area of the cart web page (figures 3A-3C, and 5, column 9, line 56 thru column 10, line 18, and column 15, line 45 thru column 16, line 5).

Claims 7, and 16, Henson discloses that the upsell advisor calculates a differential price of an upsell recommendation with respect to the price of the customer configured computer system and provides the differential price to said cart, wherein a description of the upsell recommendation, the differential price, and an upgrade now user selectable option are each displayed in a prominent area on the cart web page, and wherein upon selection of the upgrade now option by the user, said upsell advisor updates the customer configured computer system configuration with the upsell recommendation and then causes the user to reenter said cart (figures 1, 3A-3C, and 5, column 6, lines 18-43, column 9, line

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56 thru column 10, line 18, and column 15, line 45 thru column 16, line 5).

Claims 8, and 17, Henson discloses that the cart further includes merchandising recommendations for available options and their respective option details, the merchandising recommendations being presented on the cart web page in the event an upsell recommendation by said upsell advisor is unavailable, and wherein said database is further for dynamically supplying the merchandising recommendations to said cart in accordance with a prescribed customer set (column 9, line 40 thru column 10, line 29).

Claims 9, and 18, Henson discloses that the the upsell advisor validates an upsell recommendation for the given customer configured computer system prior to providing the upsell recommendation to said cart (column 7, line 56 thru column 8, line 67).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Van Wyngarden US Patent 6,038,597 Mar. 14, 2000. Linking a user system configurations with pricing and the ability to submit on-line orders.

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b) Katz et al. US Patent 6,055,513 Apr. 25, 2000. A system and method for presenting users with upsell data using e-commerce based on a primary transaction.

c) Fisher et al. US Patent 6,092,189 Jul. 18, 2000. A system for automatically installing a software according to configure to order requirements..

d) Walker et al. US Patent 6,119,099 Sep. 12, 2000. A method and system for processing supplementary product sales at apoint of sale terminal.

e) Beelitz et al. US Patent 6,182,275 Jan. 30, 2001. Generation of a compatible order for a computer system.

f) Walker et al. US Patent 6,196,458 Mar. 6, 2001. An upsell system for printing a billing statement to provide supplementary products for sales.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703) 308-6296 or 6306.

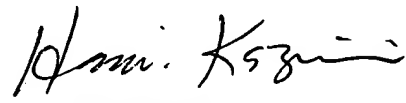
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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Respectfully Submitted

A handwritten signature in black ink, appearing to read 'Hani Kazimi', written in a cursive style.

Hani.Kazimi

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May 24, 2001